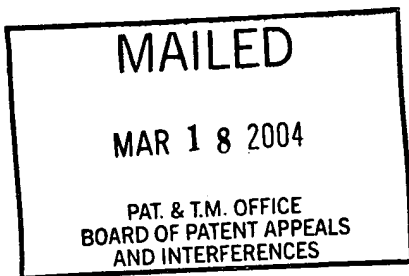


UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES



Ex parte JASON M. BREWER

Application No. 09/494,218

ORDER RETURNING TO EXAMINER

This application was received at the Board of Patent Appeals and Interferences on February 17, 2004. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith returned to the examiner. The matters requiring attention prior to docketing are identified below.

An examination of the file indicates that the grounds of rejection appearing on pages 2-7 of the Final Rejection mailed May 27, 2003 (Paper No. 4) are as follows:

1. Claims 2, 6-7, and 9 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification . . . ;
2. Claim 5 is rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Number 6,295,638 to Brown et al. ;
3. Claims 1-3, 6-7, and 9 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Number 6,295,638 to Brown et al. in view of U.S. Patent Number 6,389,589 to Mishra et al.;
4. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 6,295,638 to Brown et al. In view of U.S. Patent Number 6,389,589 to Mishra et al. as applied to claim 2 above, and further in view of U.S. Patent Number 6,263,360 to Arnold et al.; and
5. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 6,295,638 to Brown et al. in view of U.S. Patent Number 6,263,360 to Arnold et al.

Appellant reiterated the § 102 and § 103 grounds of rejection on page 3 of his Appeal Brief filed October 6, 2003 (Paper No. 6). Pages 3-7 of the Examiner's Answer mailed October 31, 2003 (Paper No. 7), lists the § 102 and § 103 grounds of rejection as follows:

1. Claim 5 is rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Number 6,295,638 to Brown et al.;
2. Claims 1-3 and 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent

Number 6,29,638 to Brown et al. in view of U.S. Patent Number 6,389,589 to Mishra et al.;

3. Claims 4 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 6,295,638 to Brown et al. in view of U.S. Patent Number 6,389,589 to Mishra et al] and further in view of U.S. patent Number 6,263,360 to Arnold et al.; and
4. Claims [sic] 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 6,295,638 to Brown et al. in view of U.S. Patent Number 6,263,360 to Arnold et al.

The rejection of claims 4 and 9 under 35 U.S.C. § 103(a) as being unpatentable to Brown (6,295,638) in view of Mishra (6,389,589) and further in view of Arnold (6,263,360) appears to be a new ground of rejection against claim 9.

On December 1, 1997, the rule pertaining to the Examiner's Answer and Reply Brief (37 CFR § 1.193) was amended to read as follows:

(a)(2) An examiner's answer must not include a new ground of rejection. . . .

Accordingly, it is

ORDERED that the application is returned to the Examiner:

1. for a determination regarding the status of claims 4 and 9 under 35 U.S.C. § 103(a) as being unpatentable

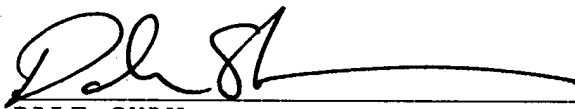
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to Brown (6,295,638) in view of Mishra (6,389,589) and further in view of Arnold (6,263,360). If this rejection is to remain, the rejection is considered to be a new ground of rejection and the entry of the Examiner's Answer mailed October 31, 2003 (Paper No. 9) is inappropriate. Accordingly, the Examiner's Answer needs to be vacated and prosecution reopened. If the rejection is to be withdrawn, the Examiner's Answer will also need to be vacated and a Supplemental Examiner's Action issued in its place.

2. for such further action as may be appropriate.

BOARD OF PATENT APPEALS
AND INTERFERENCES

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